

## **REMARKS**

This is a full and timely response to the non-final Office Action mailed August 10, 2007. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Present Status of Patent Application**

Claims 1- 20, 23-35, and 37-65 are pending in the present application. Specifically, claims 2-5, 8, 10-11, 13-17, 19-20, 23-25, 27-35, 38-39, 41, and 43-45 are original unamended claims; claims 1, 6-7, 9, 12, 18, 26, 37, 40, 42, and 46-65 have been currently amended without introduction of new matter; and claims 21-22 and 36 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

#### **A. Telephone Conversation with Examiner**

Applicants' representative thanks Examiner Wang for the telephone conversation conducted on October 9, 2007. Applicants' representative stated that several pairs of claims were rejected as being duplicative, and that the claims did actually recite different subject matter. Each pair of claims differs by a single word. Examiner Wang stated that it was possible that he missed the difference in the claim pairs, and that the response should indicate the difference. Applicants' representative next asked about the rejections pertaining to trademarks. Applicants' representative and Examiner Wang agreed that all letters in registered trademarks recited in the specification will be capitalized. Applicants' representative also pointed out the one of the terms that was rejected as an improper use of a registered trademark was not a registered trademark. Examiner Wang suggested that the response indicate this.

#### **B. Specification Objections**

##### **Statement of the Objection**

*The specification is objected to because of the following informalities:*

*“XLANG”, e.g., cited in [0005], Lin2, is a registered trademark.*

*“Microsoft” and “IBM”, e.g., cited in [0043], Line 6, are registered trademarks.*

*“BEA”, e.g., cited in [0043], Line 12, is a registered trademark.*

*Appropriate correction is required (See MPEP 608.01(b))*

**Response to the Objection**

The specification is amended to show the word “Microsoft” replaced by the upper case word “MICROSOFT” in accordance with MPEP § 608.01(v). No amendments have been carried out upon IBM and BEA because these words, corresponding to names of corporations, are already capitalized in the original specification. Further, it is respectfully submitted that neither XLANG nor XLANG/s is a currently registered trademark. (See Trademark Electronic Search System, TESS, at <http://tess2.uspto.gov/bin/gate.exe?f=searchss&state=8rtc91.1.1>). Accordingly, it is requested that the objections to the specification be reconsidered and withdrawn.

**C. Claim Rejections under 35 U.S.C. §101**

**Statement of the Rejection**

*Claims 46-59 and 60-65 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.*

**Response to the Rejection**

Claims 46-59 and 60-65 are directed to computer-readable media, which is asserted, in the instant Office Action, as being direct to non-statutory subject matter. Without prejudice or disclaimer as to whether a computer-readable medium is directed to non-statutory subject matter, claims 46-59 and 60-65 are amended to recite a “computer-readable storage medium”. Accordingly, it is requested that the rejection, under 35 U.S.C. § 101, of claims 46-59 and 60-65 be reconsidered and withdrawn.

**D. Claim Rejections under 35 U.S.C. §112**

**Statement of the Rejection**

*Claims 10-11, 24-25, 38-39, and 58-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

8. *As to claims 10-11, They have the same meaning in their respective claims; “where the instance state is being stored”, cited in claim 10, and “where the instance state is being stored”, cited in claim 11, these clauses have the same meaning.*

**Response to the Rejection**

**Claims 10 and 11**

Applicants respectfully submit that the rejection is improper. Contrary to the Office action allegation, Applicants' claim 10 cites: “...*where the instance state is being processed*” (Emphasis added) while Applicants' claim 11 cites: “...*where the instance state is being stored.*” (Emphasis added). Consequently, the scope of these two claims is distinct and different from one another. Applicants respectfully request withdrawal of the rejection followed by allowance of claims 10 and 11.

**Claims 24-25, 38-39, and 58-59**

Applicants' remarks above vis-à-vis claims 10 and 11 are equally pertinent to the rejection of claims 24-25, 38-39, and 58-59 as well. It must be further emphasized that the scope of each of these claims is distinct to one another and to claims 10 and 11 as well. Applicants respectfully request withdrawal of the rejection followed by allowance of claims 24-25, 38-39, and 58-59.

**E. Claim Rejections under 35 U.S.C. §103**

**I. Statement of the Rejection**

*Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich Roxburgh, (BizTalk Orchestration™ : Transactions, Exceptions, and Debugging, Feb. 2001, Microsoft™) hereinafter ‘Roxburgh’) in view of Shaykat Chaudhuri, (Debugging in Visual Studio .NET™, Jan. 2002, Microsoft Corporation) (hereinafter ‘Chaudhuri’).*

**Response to the Rejection**

**Claim 1**

In an effort to move forward prosecution in this case and reduce the number of items under dispute, Applicants have currently opted to amend claim 1, and respectfully submit that claim 1 is allowable over the cited prior art, at least in its currently amended form. In this matter, it may be pertinent to draw attention to MPEP 706.2(j) *Contents of a 35 U.S.C. 103*

*Rejection*, wherein the third criterion requires that the prior art references when combined must teach all the limitations of Applicants' rejected claim 1.

The subject matter of the amendment has been disclosed in various portions of Applicants' original specification. For example, paragraph [0064] describes certain aspects of Applicants' Fig. 4 (which shows a plurality of business processes 410-420), and paragraph [0069], which describes certain events specific to a particular business process. Currently amended claim 1 cites remotely debugging one business process amongst a plurality of business processes implemented on a remote computer. This is in contrast to handicaps associated with existing art, as described in the Background section of Applicants' specification, such as in paragraphs [0008] through [0010].

Applicants respectfully request withdrawal of the rejection followed by allowance of claim 1.

### **Claims 2-7 and 9-11**

Applicants respectfully submit that independent claim 1 is allowable for reasons described above. Consequently, claims 2-7 and 9-11 that are each dependent directly or indirectly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

For at least this reason, among several others, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a), followed by allowance of claims 2-7 and 9-11.

## **II. Statement of the Rejection**

*Claims 8, 12-39, and 46-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roxburgh in view of Chaudhuri and further in view of Adams et al., (Biz Talk™ Unleashed 1<sup>st</sup> Edition, Feb. 2002, Sams Publishing) (hereinafter 'Adams').*

### **Response to the Rejection**

#### **Claim 12**

In an effort to move forward prosecution in this case and reduce the number of items under dispute, Applicants have currently opted to amend claim 12, and respectfully submit that claim 12 is allowable over the cited prior art, at least in its currently amended form. As pointed out above, Applicants once again draw attention to the third criterion of MPEP 706.2(j) for support in this matter.

The subject matter of the amendment has been disclosed in various portions of Applicants' original specification. For example, paragraphs [0065] and [0066] describe certain aspects of an orchestration service as currently cited in Applicants' claim 12. Applicants respectfully traverse the Office action allegation (vis-à-vis currently canceled claim 21) that Adams discloses Applicants' message box database. However, in the interests of providing clarity, Applicants have currently defined that the message box database is used for depositing a debugging request. This functionality has been disclosed in relevant part in Applicants' paragraph [0066].

For at least this reason, Applicants respectfully assert that claim 12 is allowable and hereby request withdrawal of the rejection followed by allowance of claim 12.

**Claims 13-20 and 23-25**

Applicants respectfully submit that independent claim 12 is allowable for reasons described above. Consequently, claims 13-20 and 23-25 that are each dependent directly or indirectly on claim 12 are also allowable as a matter of law.

For at least this reason, among several others, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a), followed by allowance of claims 13-20 and 23-25.

**Claims 21-22**

Applicants have currently opted to cancel claims 21 and 22 and respectfully submit that the rejection of these claims has been rendered moot as a result of the cancellation.

**Claim 26**

In an effort to move forward prosecution in this case and reduce the number of items under dispute, Applicants have currently opted to amend claim 26, and respectfully submit that claim 26 is allowable over the cited prior art, at least in its currently amended form. The subject matter of the amendment has been disclosed in various portions of Applicants' original specification, for example, in paragraph [0061].

Applicants hereby request withdrawal of the rejection followed by allowance of claim 26.

**Claims 27-35 and 37-39**

Applicants respectfully submit that independent claim 26 is allowable. Consequently, claims 27-35, and 37-39 that are each dependent directly or indirectly on claim 12 are also

allowable as a matter of law.

For at least this reason, among several others, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a), followed by allowance of claims 27-35 and 37-39.

**Claim 36**

Applicants have currently opted to cancel claim 36 and respectfully submit that the rejection of this claim has been rendered moot as a result of the cancellation.

**Claim 46**

In an effort to move forward prosecution in this case and reduce the number of items under dispute, Applicants have currently opted to amend claim 46, and respectfully submit that claim 46 is allowable over the cited prior art, at least in its currently amended form. The subject matter of the amendment has been disclosed in various portions of Applicants' original specification, for example, in paragraph [0069].

Applicants hereby request withdrawal of the rejection followed by allowance of claim 46.

**Claims 47-59**

Applicants respectfully submit that independent claim 46 is allowable. Consequently, claims 47-59 that are each dependent directly or indirectly on claim 46 are also allowable as a matter of law.

For at least this reason, among several others, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a), followed by allowance of claims 47-59.

**III. Statement of the Rejection**

*Claims 45 and 65 are rejected under 35 U.S.C. §103(a) as being unpatentable over Adams in view of Chaudhuri.*

**Response to the Rejection**

**Claim 45**

Applicants have provided below, reasons for allowance of claim 40, and respectfully submit that claim 45 is at least allowable due to its dependency on allowable claim 40.

Applicants hereby request withdrawal of the rejection followed by allowance of claim 45.

**Claim 65**

Applicants have provided below, reasons for allowance of claim 60, and respectfully submit that claim 65 is at least allowable due to its dependency on allowable claim 60.

Applicants hereby request withdrawal of the rejection followed by allowance of claim 65.

**F. Claim Rejections under 35 U.S.C. §102**

**Statement of the Rejection**

*Claims 40-44 and 60-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams.*

**Response to the Rejection**

**Claim 40**

In an effort to move forward prosecution in this case and reduce the number of items under dispute, Applicants have currently opted to amend claim 40, and respectfully submit that claim 40 is allowable at least as a result of the amendment.

As is known, a proper rejection under 35 U.S.C. §102(b) requires that a single prior art reference disclose each element of the claim. Furthermore, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.

In light of this requirement, Applicants respectfully submit that currently amended claim 40 is allowable over the cited prior art at least for the reason that the claim now includes “*a reference to an identifier that is stored along with a set of tracked events for debugging purposes.*” The subject matter of the amendment has been disclosed in various portions of Applicants’ original specification. For example, paragraph [0062] describes certain aspects of a unique identifier and the way that this identifier is used. This feature is not disclosed in the cited prior art. Consequently, for at least this reason, Applicants respectfully assert that claim 40 is allowable and hereby request withdrawal of the rejection under 35 U.S.C. § 102(b), followed by allowance of claim 40.

**Claims 41-44**

Applicants respectfully submit that independent claim 40 is allowable. Consequently, claims 41-44 that are each dependent directly or indirectly on claim 40 are also allowable as a matter of law. For at least this reason, among several others, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b), followed by allowance of claims 41-44.

**Claim 60**

Though the scope of claim 60 is distinct and different from that of claim 40, Applicants' remarks above with reference to claim 40 are equally applicable to the rejection of claim 60 as well. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b), followed by allowance of claim 60.

**Claims 61-64**

Applicants respectfully submit that independent claim 60 is allowable. Consequently, claims 61-64 that are each dependent directly or indirectly on claim 60 are also allowable as a matter of law. For at least this reason, among several others, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b), followed by allowance of claims 61-64.

**Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

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**PATENT**

## **CONCLUSION**

Applicants respectfully submit that pending claims 1- 20, 23-35, and 37-65 are allowable. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative.

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